

## **REMARKS**

Applicants respectfully request reconsideration of the subject application in view of the amendments and remarks set forth herein.

### **1. Claim 18 - Allowed**

Applicants note with appreciation the Examiner's indication in the present Office Action that claim 18 is allowed.

### **2. Art-Based Rejections of Claims 15-17 - Moot**

Applicants note that claims 15 and 16 stand rejected under 35 USC § 102(b) based on U.S. Patent No. 5,543,940 to Sherman. In addition, claim 17 stands rejected under 35 USC § 103(a) based on the Sherman '940 patent.

While applicants do not agree and/or acquiesce in the foregoing art-based rejections, to advance prosecution to prompt allowance, applicants have herein canceled claims 15-17, without prejudice. Accordingly, applicants respectfully submit that the outstanding rejections under Sections 102(b) and 103(a) are obviated. Reconsideration and withdrawal of such rejections are respectfully requested.

### **3. Art-Based Rejections of Claims 1-10 Withdrawn**

Applicants note with appreciation that all previously advanced art-based rejections of claims 1-10 have been withdrawn in the outstanding Office Action. As is apparent from the outstanding Office Action, the Examiner has determined that claims 1-14 patentably distinguish over the art of record, including specifically U.S. Patent No. 6,546,129 to Ohta, *et al.*; U.S. Patent No. 6,302,668 to Kim; U.S. Patent No. 6,281,984 to Decker, *et al.*; and U.S. Patent No. 6,480,299 to Drakopoulos, *et al.*

### **4. Rejection Under Section 112, Second Paragraph**

Applicants note that claims 1-17 stand rejected under 35 USC § 112, second paragraph. More specifically and with specific reference to claims 1 and 13-17, the

Examiner raises issues with respect to the terms “sufficiently different,” “ordinary” and “typical,” as recited in applicants’ pending claims. In addition, the Examiner recommends “a more organized approach to claiming multiple different types of patch material (perhaps by defining a ‘first material’ and a ‘second material’ so that the claim has greater clarity when each different material is referenced).” Dependent claims 2-12 are rejected under Section 112 because they depend from a rejected base claim, i.e., independent claim 1. Reconsideration of the foregoing Section 112 rejection is respectfully requested.

First, applicants note that claims 15-17 have been canceled, without prejudice. Accordingly, the Section 112 issues set forth in the outstanding Office Action with respect to such claims are rendered moot.

Turning to independent claim 1, applicants have amended the claim language to address the examiner’s concerns, as follows:

- Recitations directed to “first and second” color reference patches;
- Recitations directed to “first and second” scanned color space values;
- Recitations directed to “first and second” material compositions; and
- Elimination of the terms “ordinarily” and “typical”.

Applicants have not eliminated the recitation directed to production of scanned color space values of “substantially as high a degree of accuracy” because, in context, applicants respectfully submit that such recitation is clear, definite and in full compliance with Section 112, second paragraph.

Applicants respectfully submit that the proposed amendments to claim 1 find ample support in the specification, as filed, and that no new matter is introduced thereby. Prompt entry of the proposed amendments to claim 1 is respectfully requested.

Applicants further submit that the proposed amendments to claim 1 address all Section 112 issues raised in the outstanding Office Action. Reconsideration and prompt allowance of independent claim 1, as amended, are respectfully requested.

Applicants have also amended dependent claims 4, 9 and 11-14 to correspond to the proposed amendments to claim 1 (and to otherwise address potential issues under Section 112, second paragraph). Applicants respectfully submit that the proposed amendments find support in the specification, as filed, and that no new matter is introduced thereby. Prompt entry thereof is respectfully requested.

In view of the foregoing amendments, applicants submit that all pending claims are in full compliance with Section 112, second paragraph. Reconsideration and prompt allowance of such claims are respectfully requested.

#### **5. Conclusion**

Applicants respectfully submit that all claims are in condition for allowance. Prompt action leading to an early Notice to this effect is earnestly solicited. If the Examiner believes that a telephone conversation may be useful in advancing prosecution of this application, he is invited to contact applicants' attorney at the number set forth below.

Respectfully submitted,



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Date: January 17, 2008

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